



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Estes et al.

Serial No.: 10/027,160

Atty. Dock. No.: 1000276-0003

Group Art Unit: 1751


Examiner: G. Webb

**Certificate of Mailing (37 CFR 1.8(a))**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to:

Assistant Commissioner for Patents  
Mail Stop: Amendment  
P.O. Box 1450  
Alexandria, VA 22313-1450

Date of Deposit: 7 May 2004

  
Dee Daum

**Supplemental Response**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Examiner's Final Office Action dated 21 January, 2004 for the above-identified patent application, please enter the enclosed Affidavit Under 37 CFR 1.131 into the record. Our Response of 21 April 2004 included the signatures of three of the four inventors. The attached Affidavit Under 37 CFR 1.131 provides the signature of the fourth inventor.

The Commissioner is hereby authorized to charge any fees required, as well as any patent application processing fees associated with this communication for which full payment has not been tendered, to Deposit Account No. 122144. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

Lord. Bissell & Brook LLP

By:   
Reg. No. 48,209

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Estes et al.

Serial No.: 10/027,160

Group Art Unit: 1751

Examiner: G. Webb

Filed: 20 Dec. 2001

Attorney Docket No. 1000276-0003

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**Affidavit Under 37 CFR 1.131**

S I R:

We the named inventors hereby declare as follows:

1. We are the named inventors of the subject matter that is claimed and for which a patent is sought on the invention as above mentioned. This application was filed on 21 Dec. 2001. This application is a divisional application of 09/520,653 (filed on 01 March 2000), which is a divisional application of 09/038,054 (filed on 11 March 1998), which claims the benefit of the earlier filing date of provisional patent application 60/045,072 (filed on 29 April 1997). As such, this application has an earliest effective filing date of 29 April 1997.

2. In the Office Action dated 21 Jan. 2004, the Examiner rejected the claims under section 102(e) as being anticipated by Sidotti (5,865,851) and under section 102(e) as being anticipated by Tyerech (5,712,240).

Sidotti issued on 02 Feb. 1999, and has a section 102(e) filing date of 18 June 1996. Tyerech issued on 27 Jan. 1998 and has a section 102(e) filing date of 01 Oct. 1996. Tyerech's priority dates to the GB applications are irrelevant with respect to section 102(e).

Because Sidotti predates Tyerech, swearing behind Sidotti equally removes Tyerech from consideration. As such, to the extent that necessary, applicants discuss the prior invention of Sidotti and Tyerech by discussing Sidotti.

3. We reviewed and understand the contents of the cited patent of Sidotti and Tyerech.

4. This written document is an affidavit of prior invention to overcome the cited patents of Sidotti and Tyerech. We, the inventors of the subject matter of the rejected claims, hereby submit this oath to overcome these references. We performed certain acts described below.

#### **I. Showing of Facts Through Document Evidence**

5. Below are facts that show a conception of the invention on or before the 18 June 1996 filing date of Sidotti coupled with due diligence from such conception to a subsequent actual reduction to practice or to the provisional application filing date of 29 April 1997.

6. **Exhibit A** is a slide show summary created and dated before 18 June 1996 (date redacted). We prepared this slide show in preparation for a presentation to Whirlpool, our employer and the assignee of the application. **Exhibit B** is a document entitled, "Non Aqueous Fluid Assessment" which sets up testing protocols using non-aqueous working fluids. This document too was generated prior to 18 June 1996.

#### **A. Facts establishing conception**

7. In general, the facts of Exhibits A and B are hereby incorporated by reference. Moreover, we present the following facts to establish a conception of the invention on or before the 18 June 1996 Sidotti filing date.

##### **1. Conception**

8. The basic inventive concept of the application is the fluid composition used in non-aqueous laundering.

9. The Examiner presented Sidotti as teaching various ingredients. In particular, the Examiner contends in paras. 7-9 that the fluorosurfactants are analogous to the working fluid. First, as explained in the contemporaneously filed Office Action Response, the mere fact that the Sidotti compound is a surfactant means it is not a working fluid as claimed. This means that Sidotti does not teach a working fluid as claimed and thus cannot anticipate.

10. The details of Exhibit A support conception of the claimed invention. Thus, the scope of this affidavit is commensurate with the scope of the claimed subject matter. Particularly, Exhibit A shows that "Project Hope" concerns working fluid chemistries. Some of the exemplary working fluids include Flourinert and possess the properties of being an ideal working fluid. The next slide shows Project Hope and the various characteristics of an exemplary non aqueous working fluid. The next slide shows that hundreds of compounds were

selected for further testing and that several were currently being bench tested. (See Exhibit B for some testing protocols).

## **2. Effective date of Sidotti**

11. As indicated on the face of the Sidotti patent, Sidotti issued on 02 Feb. 1999, and has a section 102(e) filing date of 18 June 1996. Accordingly, the date to overcome is 18 June 1996.

## **3. On or before the effective date of Sidotti**

12. We allege that the acts relied upon to establish the date on or before 19 June 1996. The testing and the exhibits attached were generated prior to the effective date of Sidotti.

## **B. Facts establishing reduction to practice**

13. In general, the facts of Exhibits A and B are hereby incorporated by reference. Moreover, we present the following facts to establish a reduction to practice.

### **1. Actual reduction to practice**

14. After conception of the invention on or before 18 June 1996, we tested or had the invention tested to establish its capacity to successfully perform its intended purpose. Exhibit B represents an invention testing protocol/assessment that discusses the experiments that would be run during a period starting before 18 June 1996 and into later parts of 1996.

15. Exhibit A shows a slide show summary generated and dated prior to 18 June 1996 that shows that of the many chemicals that exhibited the desired characteristics, several were chosen as candidates. Several were benchtop tested.

### **2. Constructive reduction to practice**

16. We allege that the present application for a U.S. patent claims the same invention disclosed in the provisional application filed on 29 April 1997.

17. Therefore, constructive reduction to practice was achieved on 29 April 1997.

## **C. Facts establishing reasonable diligence**

18. We present the following facts to establish that there was reasonable diligence from on or before the 18 June 1996 effective date of Sidotti to the actual reduction to practice of Exhibits A or B or alternatively to the provisional filing date.

19. As noted above, conception occurred on or before the 18 June 1996 filing date of Sidotti. Moreover, actual reduction to practice occurred on or before 29 April 1997. We assert that there was reasonable diligence from conception to reduction to practice, either actual or constructive. Exhibits A and B indicate that several exemplary working fluids were selected as having desirable characteristics and these chemicals were submitted for further bench testing. As Exhibit A shows, we were cognizant of the need to pursue patent applications to protect the invention. The inventors ultimately timely filed a provisional patent application on 29 April 1997. The selection of chemicals, the experiments, and the actual filing of a patent application indicate a reasonable diligence period from on or before the Sidotti filing date.

20. Alternatively, the time period taken for completion of the application constitutes reasonable diligence. During this time period, we and/or our representative worked reasonably hard and expeditiously to prepare, execute, and file an application in the United States. Accordingly, there was reasonable diligence from on or before the Sidotti filing date to the filing of the application of the present invention.

## **II. Allegations and other statements**

21. We allege that the acts relied upon to establish the date on or before Sidotti were carried out in the United States.

## **III. Signatures and Declaration in Lieu of Oath Under 37 CFR 1.68**

22. We hereby declare that the statements made of my own knowledge are true and that all statements made on information and belief are believed to be true. We acknowledge that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon.

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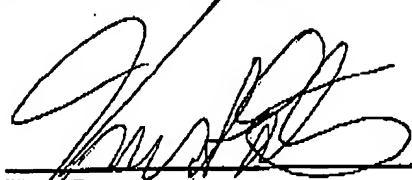
Tremitchell Wright Date

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Mark Kovich Date

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Daniel Conrad Date



5-3-04

Kurt Estes

Date



1757

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Alexandria, VA 22313-1450

Date of Deposit: 7 May 2004

Dee Daum

**Transmittal Letter**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Enclosed is a Supplemental Response to the 21 January 2004 Final Office Action and an Affidavit Under 37 CFR 1.131.

Also enclosed is:

Return Receipt Postcard

The Commissioner is hereby authorized to charge any fees required, as well as any patent application processing fees associated with this communication for which full payment has not been tendered, to Deposit Account No. 122144. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

Lord, Bissell & Brook LLP

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